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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,961	09/29/2006	Toru Maeda	070456-0154	5771

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MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER	
SHEEHAN, JOHN P	

ART UNIT	PAPER NUMBER
1793	

MAIL DATE	DELIVERY MODE
08/25/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/594,961	MAEDA ET AL.	
	Examiner	Art Unit	
	John P. Sheehan	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1, 2 and 5-7* is/are allowed.

6)☒ Claim(s) *4 and 8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 4 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Satsu et al. (Satsu ‘219, US Patent No. 6,054,219, cited in the IDS submitted December 10, 2008).

Satsu '219 teaches a soft magnetic powder. The disclosed soft magnetic powder is coated with an insulating layer and subsequently pressure formed to form a dust core which is heat treated (Example 1, column 9, line 38 to column 10, line 30). Satsu ‘219 teaches that the soft magnetic powder is made by atomization as recited in the applicants' claims (for example see, column 10, lines 11, 18, 35, 39, and 42 and Examples 1 to 3 and Comparative Examples 1 to 3).

The claims and Satsu '219 differ in that Satsu '219 does not teach etching and heat treating the soft magnetic powder as recited in applicants' product by process claims 4 and 8.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because applicants' and Satsu '219's soft magnetic powders are each made by atomization any difference(s) in process steps, that is, the claimed etching step and heat treatment step, do not necessarily lend patentability to the claimed product, MPEP 2113.

> "[E]ven though product-by-process claims are lim - ited by and defined by the process, determination of patentability is based on the product itself. The patent- ability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe* ,777 F.2d 695,698,227 USPQ 964,966 (Fed. Cir.1985.

It is noted that the use of a rejection under 35 USC 102/103 for product by process claims as set forth above has been approved by the courts, see MPEP 2113.

> "[T]he lack of physical description in a product-by- process claim makes determination of the patentabil - ity of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art dis - closes a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to

> manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown* , 459 F.2d 531,535,173 USPQ 685,688 (CCPA 1972).

Response to Arguments

4. Applicant's arguments filed June 5, 2009 have been fully considered but they are not persuasive.

5. The rejection of claims 1, 2 and 5 to 7 under 35 U.S.C. 103 (a) as being unpatentable over Satsu '219 in view of Takashi '602 has been overcome by applicants' arguments. Accordingly, claims 1, 2 and 5 to 7 are allowed.

6. Applicants' arguments based on applicants' statement that Satsu '219 does not disclose or suggest an atomization step are not persuasive. Satsu '219 teaches that the soft magnetic powder is made by atomization as recited in each of the applicants' product by process claims (for example see, column 10, lines 11, 18, 35, 39, and 42 and Examples 2 to 3 and comparative Examples 1 to 3). Further, because Satsu '219's soft magnetic powder and applicants' claimed soft magnetic powder are made by atomization as recited in applicants' product by process claims any difference(s) in process steps, that is, the claimed etching step and heat treatment step, do not necessarily lend patentability to the claimed product, MPEP 2113.

> "[E]ven though product-by-process claims are lim - ited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the

> prior product was made by a different process." *In re Thorpe* ,777 F.2d 695,698,227 USPQ 964,966 (Fed. Cir.1985.

7. In making their arguments, applicants have referred to Figures 3 and 4 of the present application (applicants' response, page 6, second full paragraph), however, it is not clear what point applicants are attempting to make, for example, how these Figures distinguish applicants' atomized powder form Satsu '219's atomized powder.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/
Primary Examiner, Art Unit 1793

JPS